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OFFICE OF PETITIONS

In re Application Of:

Jean Goudreau

Application No. 10/764,564

Filed: January 27, 2004

Attorney Docket No. GB/13598.2

Title: COMPOSITE FRENCH DOOR

DECISION ON PETITION UNDER
37 C.F.R. §1.47(b)

This is in response to the petition under 37 C.F.R. §1.47(b)¹, filed on December 13, 2004.

The above-identified application was filed on January 27, 2004, without an executed oath or declaration and identifying Jean Goudreau as the sole inventor. On June 14, 2004, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring an executed oath or declaration in compliance with 37 CFR §1.63 and the surcharge for the late filing of the oath or declaration. The notice set a two-month period for reply.

In reply, applicant filed the instant petition, along with the associated fee, the fee associated with the late filing of an oath or declaration, a four-month extension of time to make timely this response, and copies of several letters and e-mails.

Petitioner has not stated whether she is asserting that the non-signing inventor has refused to sign or that he cannot be found. Since a copy of the declaration was

¹ A grantable petition under 37 CFR §1.47(b) requires:

- (1) The petition fee;
- (2) a surcharge if the petition was not filed at the time of filing of the application;
- (3) a statement of the last known address of each of the non-signing inventors;
- (4) proof that a copy of the application was sent or given to each of the non-signing inventors for review;
- (5) proof that each of the non-signing inventors refused to sign;
- (6) proof that the Rule 47(b) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application;
- (7) proof of irreparable damage, and;
- (8) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116 and 37 CFR §1.63.

purportedly sent to him, the Office will assume the former. Petitioner must notify the Office in writing if this is not a correct interpretation.

Petitioner has met requirements (1) - (2) above.

Regarding the third requirement, petitioner has failed to include a statement of the last known address of the non-signing inventor². On renewed petition, Petitioner should provide the same.

Regarding the fourth and fifth requirements, petitioner has not shown that a *complete* copy of the application was sent to the non-signing inventor. First, Petitioner has stated that the only item which was sent to the inventor was the declaration. None of the letters or the e-mails state that a copy of the application was enclosed. Had the application been included, it seems that it would have been mentioned in the petition and in each of the letters. As such, it is clear that the Rule 47 applicant did not present the inventor with a copy of the entire application.

Secondly, each of the letters and the e-mails were sent by someone other than the Petitioner, and as such, she does not have first-hand knowledge of the events.

Furthermore, none of the e-mails and the letters appear to be related to the instant application, as the reference numbers do not match up with the attorney docket number listed on the declaration.

It follows that one cannot refuse to sign something which one has not been presented with. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR §1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed³.

On renewed petition, Petitioner should send a complete copy of the application to the inventor at his last known address and wait an appropriate time before determining that he has refused to execute the application.

Regarding the sixth requirement above, Rule 47(b) applicant has failed to prove sufficient proprietary interest in the subject matter to justify the filing of the application⁴. Petitioner has included a copy of the Assignment document, but it is noted that the document has not been executed. As such, it appears that the inventor never assigned any rights in the present invention to Rule 47(b) applicant. On renewed petition, the petitioner should provide either an executed assignment showing that the invention disclosed in the application is assigned to Rule 47(b) applicant, or; a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would, by the weight of the authority, award title to the invention to the Rule 47(b) applicant.

² See MPEP 409.03(e).

³ *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

⁴ See MPEP §409.03(f).

Regarding the seventh requirement above, no proof of irreparable damage has been submitted⁵. A statement by Rule 47(b) applicant that the filing is necessary to preserve the rights of the parties would be sufficient.

Regarding the eighth requirement above, the declaration cannot be accepted as nobody has executed the declaration on behalf of the inventor. See MPEP 409.03(b)(A). On renewed petition, Petitioner should have this deficiency rectified.

For these reasons, the petition under 37 C.F.R. 1.47(b) must be **DISMISSED**.

Any reply must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §1.47(b)." This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition under 37 C.F.R. §1.47(b) should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski.

To help assure prompt and proper attention to your response, please see Request for Alert Concerning Submitted Petitions, 1282 Official Gazette (May 18, 2004) for further information on how to assist the Office in delivering your submission to the correct location. The Petitioner may wish to consider telephoning the undersigned one month after the submission is made to confirm that the documents were properly delivered.

Any renewed petition may be submitted by mail⁶, hand-delivery⁷, or facsimile⁸.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.



Paul Shanowski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

⁵ See MPEP §409.03(g).

⁶ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁷ Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

⁸ (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned, which could be as much as one month.